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10/569,229	02/23/2006	Hiroyuki Atake	Q93395	7824
23373 7590 12/06/2010 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER ABRAHAM, AM/AD A				
ART UNIT		PAPER NUMBER		
1744				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/569,229

Applicant(s)

ATAKE, HIROYUKI

Examiner

AMJAD ABRAHAM

Art Unit

1744

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/06/2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is a final office action in response to Applicant's remarks and amendments filed on September 30, 2010. Claims 1, 5, and 6 are currently amended. Claims 1-6 are still pending review in this action.

New grounds of rejection due to applicant's amendment filed on September 30, 2010.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atake (USP No. 6,325,607) in view of Yamazaki (JP 05-278065 – already made of record).

4. Regarding claims 1 and 5-6, Atake teaches an injection molded-in foil decoration apparatus. **(See abstract).**

a. The apparatus comprising:

i. A male mold.

(1) **See part 25 of figure 1.**

ii. A female mold.

(2) **See part 12 of figures 1-2.**

iii. A transport chuck system for feeding a decorative sheet between a male mold and said female mold.

(3) **See part 57 of figure 2.**

iv. A clasper for pressing and fastening said sheet on a parting surface of said female mold

(4) **See part 20 in figure 2.**

v. Wherein the transport chuck system comprises two clamping devices (pinching chucks) on each side of the decorative sheet.

(5) **See parts 60 of figure 2.**

vi. Wherein said clasper comprises a pushing frame that abuts on the parting surface of said female mold thereby pressing the sheet.

- (6) **See part 20 of figure 2 showing clamper (rectangular section of part 20 is the pushing frame).**
- (7) **See figures 4-5 showing parts 20 (clamper) abutting against the parting surface of the female mold (12).**
- vii. At least one connecting member in which a means of driving is connected to in order to move the pushing frame.
- (8) **See connecting member (parts around rectangular pushing frame) in part 20 in figures 1-2.**
- (9) **Connecting member can be considered two horizontal plates which support the rods (24).**
- (10) **See drive means (rods) in par 24 of figure 1.**
- viii. Wherein the clamper is formed in such a way that when the pushing frame (rectangular portion of part 20) contacts the parting surface (14) of the female mold—there is a space between the connecting member and the parting surface. **(See figures 4-5, column 7 lines 43-52, and column 12 lines 19-31).**
- (11) See figure 5 depicted below--- The lines emanating from parts 21, 64, 66, and 67 to a common point on the parting surface of the female mold show the space between the connecting member and the parting surface.

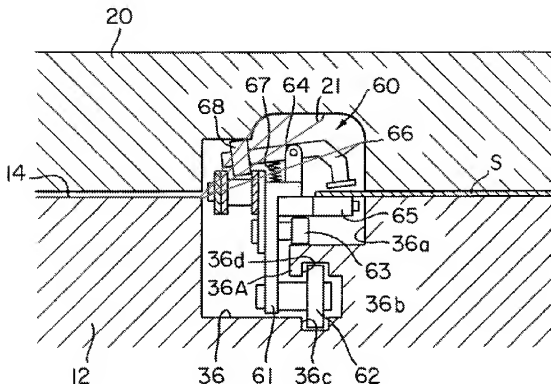


FIG. 5

b. Additionally with regards to claim 6, Atake teaches a means for feeding the decorative sheet into the clamping position. **(See part 5 of figure 2 and parts 60).**

ix. The claim limitation, "means for feeding", is a means plus function limitation that invokes 35 USC 112 6th paragraph and the corresponding structure is seen in figure 2 part 31 of applicant's specification. Part 31 of figure 31 are clamping/gripping devices which grip and move a feed sheet into position in the injection molding machine.

- c. With respect to claims 1, and 5-6, Atake does not expressly teach the parting surface is flat. However, Atake suggests that the parting surface can be planar as opposed to curved. **(See column 4 lines 59-67).**
- d. Yamazaki teaches wherein the parting surface of a mold can be flat. **(See parts 13 of figures 1-13).**
 - x. It would have been obvious to one having the ordinary skill in the art to use a flat parting surface depending on configuration of the final product being produced. It would have been obvious to one having the ordinary skill in the art at the time the invention was made to make the parting surface flat, since it had been held that the configuration was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration claimed was significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).
- e. Additionally, Yamazaki teaches wherein a space can be a connecting member (30A) and the parting surface (13) so that a clamping mechanism (30b) can fit. **(See drawing 4).**
 - xi. It would have been obvious to one having the ordinary skill in the art that the groove for the clamping mechanism can either be in the female mold/ parting surface (as seen in Atake) or in the clamping frame (as seen in Yamazaki) as there is only a finite numbers of spaces which would allow the film to be held and injection molded simultaneously.

5. Regarding claim 2, Atake teaches wherein the transport chuck is movable in a direction perpendicular to the direction of the movement of the male mold in respect to the female mold and wherein a reel is fixed to a female mold to supply sheet.

f. **See figure 1 showing sheet being fed from a reel system to a position between a closable female and male mold. (See figure 1).**

6. Regarding claim 3, Atake teaches additionally comprising feeding said decorative sheet between said male mold and said female mold by moving said clamping devices of said transport chuck with said decorative sheet being clamped by said clamping devices, pressing and fastening said sheet onto said parting surface by said clasper, releasing the grasping of said sheet by said clamping devices while maintaining the pressed state, and bringing said clamping devices back to their original position through the space between said damper and said female mold.

g. **See figures 1-5.**

h. **See column 4 lines 39-58.**

i. **See column 6 lines 30-44.**

j. **See column 7 lines 43-52.**

k. **See column 12 lines 19-31.**

7. Regarding claim 4, Atake teaches feeding said decorative sheet between said male mold and said female mold by moving said clamping devices of said transport chuck with said sheet being clamped by said clamping devices; pressing and fastening said sheet onto said parting surface of said female mold by said clasper; releasing the grasping of said sheet by said clamping devices while maintaining the pressed state;

bringing said clamping devices back to their original position through the space between said damper and said female mold; and separating said female mold and said female mold while simultaneously feeding a new decorative sheet between said male mold and said female mold by said transport chuck.

- l. **See figures 1-5.**
- m. **See column 4 lines 39-58.**
- n. **See column 6 lines 30-44.**
- o. **See column 7 lines 43-67.**
- p. **See column 12 lines 19-31.**

Response to Arguments

8. Applicant's arguments with respect to claims 1-6 have been considered but are unpersuasive and/or moot in view of the new ground(s) of rejection.

9. **Applicant Argument #1:**

- q. That Atake does not clearly disclose an established space between a connecting member of the clasper and the parting surface.

10. **Examiner Response #1:**

- r. However, the entire horizontal plate (the area between and including rods 24 of figure 2) of the clasper (20) can be considered a part of the connecting member. Thus it is this connecting member (20) which is shown in figure 5. Therefore the connecting member and parting surface of Atake form a space which allows the clamping device to pass through. Examiner would like to further

point out that applicant has not claimed the exact structure of the clasper or the structure of the connecting member. So examiner is not limited to the configuration shown in applicant's drawings. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., **[wherein the connecting member must stick out from a rectangular frame]**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

s. In the alternative, even if Atake does not teach wherein the space is formed between the parting surface and the clasper. Yamazaki teaches wherein a space can be a connecting member (30A) and the parting surface (13) so that a clamping mechanism (30b) can fit. **(See drawing 4)**. It would have been obvious to one having the ordinary skill in the art that the groove for the clamping mechanism can either be in the female mold/ parting surface (as seen in Atake) or in the clamping frame (as seen in Yamazaki) as there is only a finite numbers of spaces which would allow the film to be held and injection molded simultaneously.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMJAD ABRAHAM whose telephone number is (571)270-7058. The examiner can normally be reached on Monday through Friday 8:00 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAA

/Philip C Tucker/

Supervisory Patent Examiner, Art Unit 1745